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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,333	11/19/2001	Yuichi Narita	110982	8553

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EXAMINER	
LASTRA, DANIEL	
ART UNIT	**PAPER NUMBER**
3622	

MAIL DATE	DELIVERY MODE
11/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/988,333	NARITA ET AL.	
	Examiner	Art Unit	
	DANIEL LASTRA	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08/31/2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-36 have been examined. Application 09/988,333 (AWARD POINT SERVICE SYSTEM, RECORDING MEDIUM FOR USE THEREIN AND AWARD POINT SERVICE METHOD) has a filing date 11/19/2001 and foreign priority 11/20/2000.

Response to Amendment

2. In response to Final Rejection filed 06/01/2007, the Applicant filed an RCE on 08/31/2007, which amended claims 1, 19, 23-25, 27, 29, 30 and added new claims 31-36.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Postrel (US 6,594,640) in view of Taylor (US 5,578,808).

Claim 1, Postrel teaches:

An award point service system, comprising:

a network comprising:

a point issuing device that issues points to a customer who purchases an article (see col 9, lines 55-65);

a first memory that stores data of the points issued to the customer (see col 9, lines 55-65) in at least one virtual store on the network (see col 4, lines 5-40);

wherein the at least one virtual store established on the network is accessible to the point issuing device (see figure 4); and wherein the at least one actual store is accessible to the point reducing device (see col 9, lines 55-65 "vender associated with a computer connected to the Internet"). Postrel fails to teach a second memory that stores data of the points issued to the customer in at least one actual store; a data access permitting device that permits the data of the points issued to the customer to be read from the first and second memories; and a point reducing device that allows use of at least a part of the points read from the first and second memories by subtracting the at least part of the points from the data of the points stored in the first and second memories. However, Taylor teaches a smart card that stores point information from a plurality of vendors in different memories areas linked to said vendors and where said points are used as payment for purchases (see col 3, lines 20-40; col 7, lines 35-50). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Postrel's smart card would have a plurality of memories which would store point information from a plurality of vendors, as taught by Taylor in order to link awarded points with the issuing vendor of said awarded points and use said awarded points from different vendors as payment for purchases.

Claim 2, Postrel teaches:

An award point service system according to claim 1, wherein the at least one actual store is accessible to the point issuing device (see col 9, lines 55-65).

Claim 3, Postrel teaches:

An award point service system according to claim 1, wherein the at least one virtual store is accessible to the point reducing device (see col 4, lines 4-45).

Claim 4, Postrel teaches:

An award point service system according to claim 2, wherein the at least one virtual store is accessible to the point reducing device (see col 4, lines 4-45).

Claim 5, Postrel teaches:

An award point service system according to claim 1, further comprising a managing device that manages the points issued by the point issuing device and the points reduced by the point reducing device (see col 4, lines 5-45).

Claim 6, Postrel teaches:

An award point service system according to claim 2, further comprising a managing device that manages the points issued by the point issuing device and the points reduced by the point reducing device (see col 4, lines 5-45).

Claim 7, Postrel teaches:

An award point service system according to claim 3, further comprising a managing device that manages the points issued by the point issuing device and the points reduced by the point reducing device (see col 4, lines 5-45).

Claim 8, Postrel teaches:

An award point service system according to claim 4, further comprising a managing device that manages the points issued by the point issuing device and the points reduced by the point reducing device (see col 4, lines 5-45).

Claim 9, Postrel teaches:

An award point service system according to claim 1, wherein the data access permitting device comprises a terminal provided in the actual store (see col 9, lines 55-65), and the terminal receives the data of the points from a recording medium owned by the customer and supplies the recording medium with the data of the points (see col 9, lines 55-65).

Claim 10, Postrel teaches:

An award point service system according to claim 2, wherein the data access permitting device comprises a terminal provided in the actual store, and the terminal receives the data of the points from a recording medium owned by the customer and supplies the recording medium with the data of the points (see col 9, lines 55-67).

Claim 11, Postrel teaches:

An award point service system according to claim 4, wherein the data access permitting device comprises a terminal provided in the actual store, and the terminal receives the data of the points from a recording medium owned by the customer and supplies the recording medium with the data of the points (see col 9, lines 55-67).

Claim 12, Postrel teaches:

An award point service system according to claim 3, wherein the data access permitting device comprises a terminal provided in the actual store, and the terminal receives the data of the points from a recording medium owned by the customer and supplies the recording medium with the data of the points (see col 9, lines 55-67).

Claim 13, Postrel teaches:

An award point service system according to claim 5, wherein the data access permitting device comprises a terminal provided in the actual store, and the terminal receives the data of the points from a recording medium owned by the customer and supplies the recording medium with the data of the points (see col 9, lines 55-67).

Claim 14, Postrel teaches:

An award point service system according to claim 9, wherein the recording medium comprises a medium used for making a payment (see col 9, lines 55-65).

Claim 15, Postrel teaches:

An award point service system according to claim 9, wherein the terminal is a point of sale (POS) terminal (see col 10, lines 1-10).

As per claim 16, Postrel teaches:

An award point service system according to claim 9, wherein the terminal is a credit authorization terminal (CAT) (see col 10, lines 1-10).

As per claim 17, Postrel teaches:

An award point service system according to claim 1, further comprising:

a credit company that issues credit to the customer comprising:

a first credit company memory for storing data of the points issued to the customer in virtual stores (see col 5, lines 45-55; "credit card server capable of holding a user's earned rewards");

a credit company virtual server connected to the first credit company memory that is configured to communicate with the at least one virtual store (see figure 4, item 12); and

Postrel fails to teach a second credit company memory for storing data of the points issued to the customer in an actual store;

a credit company actual server connected to the second credit company memory that is configured to communicate with the at least one actual store,

wherein the customer can purchase items from the at least one virtual store and the at least one actual store with credit (see col 10, lines 1-15).

However, Taylor teaches a smart card that stores point information obtained from a plurality of actual vendors obtained from purchases made using a credit card (see col 6, liens 1-10). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Postrel's credit card server would have a plurality of memories which would store point information from a plurality of credit card issuers, being said points obtained from actual or virtual stores, as taught by Taylor in order to link awarded points with the issuing vendor of said awarded points and use said awarded points from different vendors as payment for purchases.

Claim 18, Postrel teaches:

An award point service system according to claim 17 further comprising:

an information processing center communicatively connected to the credit company actual server and credit company virtual server that processes purchases made under credit by the customer wherein the credit company actual server communicates with the at least one actual store via the information processing center (see col 10, lines 1-10).

Claim 19, Postrel teaches:

An award point service system, comprising:

a network comprising:

a point issuing device that issues points to a customer who purchases an article (see col 9, lines 55-65);

a first memory that stores data of the points issued to the customer (see col 9, lines 55-65) in at least one virtual store (see col 9, lines 55-65);

a data access permitting device that permits the data of the points issued to the customer to be read from the memory (see col 9, lines 55-65), and

a point reducing device that allows use of at least a part of the points read from the memory by subtracting the at least part of the points from the data of the points stored in the memory (see col 9, lines 55-65); wherein the at least one virtual store established on the network is accessible to the point reducing device (see col 4, lines 1-45); and wherein the at least one actual store is accessible to the point issuing device (see col 9, lines 55-65). Postrel fails to teach a second memory that stores data of the points issued to the customer in at least one actual store. However, Taylor teaches a smart card that stores point information from a plurality of vendors in different memories areas linked to said vendors and where said points are used as payment for purchases (see col 3, lines 20-40; col 7, lines 35-50). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Postrel's smart card would have a plurality of memories which would store point information from a plurality of vendors, as taught by Taylor in order to link awarded

points with the issuing vendor of said awarded points and use said awarded points from different vendors as payment for purchases.

Claim 20, Postrel teaches:

An award point service system according to claim 19, wherein the at least one virtual store is accessible to the point issuing device (see col 4, lines 1-45).

Claim 21, Postrel teaches:

An award point service system according to claim 19, wherein the at least one actual store is accessible to the point reducing device (see col 9, lines 55-65).

Claim 22, Postrel teaches:

a credit company that issues credit to the customer comprising:

a first credit company memory for storing data of the points issued to the customer in virtual stores (see col 5, lines 45-55; "credit card server capable of holding a user's earned rewards");

a credit company virtual server connected to the first credit company memory that is configured to communicate with the at least one virtual store (see figure 4, item 12 and 30); and

Postrel fails to teach a second credit company memory for storing data of the points issued to the customer in an actual store;

a credit company actual server connected to the second credit company memory that is configured to communicate with the at least one actual store,

wherein the customer can purchase items from the at least one virtual store and the at least one actual store with credit.

However, Taylor teaches a smart card that stores point information from a plurality of vendors in different memories areas linked to said vendors and where said points are used as payment for purchases (see col 3, lines 20-40; col 7, lines 35-50). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Postrel's credit card server would have a plurality of memories which would store point information from a plurality of vendors, being said vendors actual or virtual stores as taught by Taylor in order to link awarded points with the issuing vendor of said awarded points and use said awarded points from different vendors as payment for purchases.

Claim 23, Postrel teaches:

An award point service system according to claim 19, wherein the data access permitting device comprises a terminal provided in *one of the at least one* actual store, and the terminal receives the data of the points from a recording medium owned by the customer and supplies the recording medium with the data of the points (see col 9, lines 55-65).

Claim 24, Postrel teaches:

An award point service system according to claim 20, wherein the data access permitting device comprises a terminal provided in *one of the at least one* actual store, and the terminal receives the data of the points from a recording medium owned by the customer and supplies the recording medium with the data of the points (see col 9, lines 55-65).

Claim 25, Postrel teaches:

An award point service system according to claim 21, wherein the data access permitting device comprises a terminal provided in *one of* the *at least one* actual store, and the terminal receives the data of the points from a recording medium owned by the customer and supplies the recording medium with the data of the points (see col 9, lines 55-65).

Claim 26, Postrel teaches:

An award point service system according to claim 23, wherein the recording medium comprises a medium used for making a payment (see col 9, lines 55-65).

Claim 27, Postrel teaches:

A *computer-readable* recording medium used in a point service system including *a network comprising* an award point issuing device that issues points to a customer who purchases an article, a first memory that stores data of the points issued to the customer (see col 9, lines 55-65) from at least one virtual store, and wherein the recording medium stores the points issued or reduced by any of the at least one virtual store and the at least one actual store (see col 9, lines 55-65). Postrel fails to teach a second memory that stores data of the points issued to the customer from at least one actual store, *a tie-up company comprising the first and second memories,* a data access permitting device that permits the data of the points issued to the customer to be read from the first and second memories and a point reducing device that allows use of at least a part of the points read from the first and second memories by subtracting the at least part of the points from the data of the points stored in the first and second memories, *the recording medium comprising: a first working file that stores points and a*

second working files that stores information identifying the tie-up company, wherein the recording medium transmits and receives the data of the points to and from the *first and second memories via the* data access permitting device. However, Taylor teaches a smart card that stores point information from a plurality of vendors in different memories areas linked to said vendors and where said points are used as payment for purchases (see col 3, lines 20-40; col 7, lines 35-50). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Postrel's smart card would have a plurality of memories which would store point information from a plurality of vendors, as taught by Taylor in order to link awarded points with the issuing vendor of said awarded points and use said awarded points from different vendors as payment for purchases.

Claim 28, Postrel teaches:

A recording medium according to claim 27, comprising an IC card having an IC chip (see col 9, lines 55-65).

Claim 29, Postrel teaches:

An award point service management method for use with an award point service system comprising the steps of issuing points to a customer who purchases an article in at least one of virtual stores established on a network;

recording the issued points in the first memory (see col 9, lines 55-65); and

subtracting points used by the customer *in at least one of a actual stores* from the data of the points stored in *the first* memory such that the points are used by the

customer for purchasing an article in the at least one of actual stores (see col 9, lines 55-65).

Postrel fails to teach *a network comprising a tie-up company having* a first memory that stores points relating to purchases made by the customer in at least one of virtual stores and a second memory that stores points relating to purchases made by the customer in at least one of actual stores, *the tie-up company managing points issued to users from a plurality of stores*. However, Taylor teaches a smart card that stores point information from a plurality of vendors in different memories areas linked to said vendors and where said points are used as payment for purchases (see col 3, lines 20-40; col 7, lines 35-50). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Postrel's smart card would have a plurality of memories which would store point information from a plurality of vendors, as taught by Taylor in order to link awarded points with the issuing vendor of said awarded points and use said awarded points from different vendors as payment for purchases.

Claim 30, Postrel teaches:

An award point service management method for use with an award point service system comprising the steps of:

issuing points to a customer who purchases an article in at least one of actual stores (see col 9, lines 55-65);

recording the issued points in the second memory (see col 9, lines 55-65);

Postrel fails to teach having a *network comprising a tie-up company having a* first memory that stores points relating to purchases made by the customer in at least one of virtual stores and a second memory that stores points relating to purchases made by the customer in at least one of actual stores, *the tie-up company managing points issued to users from a plurality of stores* and transferring at least a portion of the points in the second memory to the first memory and subtracting points used by the customer *in at least one of virtual stores* from the data of the points stored in the first memory such that the points are used by the customer for purchasing an article in the at least one of virtual stores. However, Taylor teaches a smart card that stores point information from a plurality of vendors in different memories areas linked to said vendors and where said points are used as payment for purchases (see col 3, lines 20-40; col 7, lines 35-50). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Postrel's smart card would have a plurality of memories which would store point information from a plurality of vendors, as taught by Taylor in order to link awarded points with the issuing vendor of said awarded points and use said awarded points from different vendors as payment for purchases.

Claims 31 and 34, Postrel fails to teach:

wherein the first memory stores points issued by two or more virtual stores and the second memory stores points issued by two or more actual stores. However, Taylor teaches a smart card that stores points issued from stores that accepts visa, American-express cards (see figure 1). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Postrel's

smart card would use the Taylor system to stores points from a plurality of virtual or actual stores in the memory of said card.

Claims 32 and 35, Postrel fails to teach:

wherein all of the points issued by virtual stores are stored in the first memory and all of the points issued by actual stores are stored in the second memory. However, Taylor teaches a smart card that stores points from different vendors in said smart card memory and where each vendor has each own section in said smart card (see figure 1). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Postrel's smart card would use the Taylor system to stores points from a plurality of virtual or actual stores in a memory of said card in order to differentiate between different vendors that provided with said points.

Claims 33 and 36, Postrel fails to teach:

further comprising at least one tie-up company comprising the first and second memories. However, Taylor teaches a smart card where a single company (i.e. visa) can occupy different memories to stores different points in said card (see figure 4, "visa debit and credit"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Postrel would use the Taylor system to stores points from a plurality of virtual or actual stores in a memory of a smart card in order to differentiate the source of said earned points.

Response to Arguments

4. Applicant's arguments filed 08/31/2007 have been fully considered but they are not persuasive. The Applicant argues that Taylor does not discuss any memory that

stores points only for virtual stores or that store points only for actual stores. The Examiner answers that Taylor teaches a smart card with a plurality of memories where said plurality of memories stores points from different vendors, such as airlines, hotels, duty-free shops, supermarkets (see figure 1; col 3, lines 60-67). Postrel teaches a smart card which stores points earned in virtual stores. Therefore, it would have been obvious to a person of ordinary skill to combine Postrel and Taylor to obtain a smart card that stores points from virtual and actual stores.

The Applicant argues that Postrel and Taylor do not teach claims 1 and 19 because a smart card is not constituent part of a network, and therefore, according to the Applicant, a memory on the smart card is not a memory on a network. The Examiner answers that the Applicant is arguing about limitation not stated in the claims because Applicant's claims 1 and 19 do not mention anything that a smart card is not part of a network. Furthermore, in other to store data in the Postrel and Taylor's smart card, said smart card would need to be connected to a network in order to download said data to said card.

The Applicant argues that Postrel and Taylor do not teach claims 17-18 and 22. The Examiner answers that Postrel teaches a credit card server that stores points earned by member of a credit card company (see figure 1, item 12) where said points are earned in virtual stores (see col 5, lines 45-55). Taylor teaches a smart card that stores point information obtained from a plurality of actual vendors obtained from purchases made using a credit card (see col 6, liens 1-10). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was

made, to know that Postrel's credit card server would have a plurality of memories which would store point information from a plurality of credit card issuers, where said points would be obtained from actual or virtual stores, as taught by Taylor in order to link awarded points with the issuing vendor of said awarded points and use said awarded points from different vendors as payment for purchases.

The Applicant argues that Postrel and Taylor do not teach a tie-up company. The Examiner answers that Postrel teaches a smart card that stores points earned in a virtual stores and Taylor teaches a smart card where each company (*i.e.* visa) can have different memories sections in said smart card to stores points from different transactions (see figure 4, visa debit, visa credit). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Postrel's credit card companies would have a plurality section in a smart card, as taught by Taylor to store the points earned in virtual or actual stores and therefore, give users of said card the flexibility to use said card in a plurality of vendors.

The Applicant argues that neither Postrel nor Taylor, disclose a tie-up company independent from any vendors. The Examiner answers that the Applicant is arguing about limitations not stated in the claims. Nowhere, in Applicant's claims is recited anything that a tie-up company is independent from any vendor.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra
November 5, 2007

Index of Claims

Application/Control No.	Applicant(s)/Patent under Reexamination
09/988,333	NARITA ET AL.
Examiner	**Art Unit**
DANIEL LASTRA	3622

√	Rejected	–	(Through numeral) Cancelled	N	Non-Elected	A	Appeal
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Claim		Date
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